

REMARKS

This Application has been carefully reviewed in light of the Non-Final Office Action mailed January 26, 2009. At the time of the Office Action, Claims 25-34 were pending in this Application and were rejected. Applicant respectfully requests reconsideration and favorable action in this case.

Rejections under 35 U.S.C. §102

Claims 25, 26, 32, 33 and 34 were rejected by the Examiner under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,788,463 issued to Chan ("Chan"). Applicant respectfully traverses and submits the cited art does not teach all of the elements of the claimed embodiment of the invention.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, "the identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co. Ltd.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Applicant respectfully submits that the art cited as anticipatory by the Examiner cannot anticipate the rejected Claims, because the cited art does not show all the elements of the present Claims.

With regard to claim 25, the Office Action states that Chan discloses a remote actuator, a pump, and a control line connecting the remote actuator and the pump. However, the element identified by Chan as the control line (*i.e.*, element 45) connects a pump having an actuator that may be disposed remotely (element 10) with a cement mixing container (element 20). Additionally, claim 25 recites that the control line is adapted to advance the piston of the pump. In contrast, Chan teaches that the piston assembly (55) of the pump (10) is advanced by actuation of piston rod 60. As such, Chan does not set forth every element of claim 25, and therefore cannot anticipate claim 25. For at least these reasons, Applicant submits that claim 25 is in condition for allowance and respectfully requests withdrawal of the rejection.

Claims 26, 32, 33, and 34 depend either directly or indirectly from claim 25. Applicant hereby repeats and incorporates the above comments with regard to claim 25. For at least these

reasons, Applicant submits that claims 26, 32, 33, and 34 are in condition for allowance and respectfully request withdrawal of the rejection.

Rejections under 35 U.S.C. §103

Claims 27-31 were rejected under 35 U.S.C. §103(a) as being unpatentable over Chan. Applicant respectfully traverses and submits the cited art, even if proper, which Applicant does not concede, does not render the claimed embodiment of the invention obvious.

When determining whether a claim is obvious, the Examiner must make “a searching comparison of the claimed invention – *including all its limitations* – with the teaching of the prior art.” *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (emphasis added). All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Further, it is well settled that obviousness requires at least a suggestion of all the features in a claim. *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) (*citing In re Royka*, 490 F.2d 981, 985 (CCPA 1974)). Moreover, as the Supreme Court recently stated, “*there must be some articulated reasoning* with some rational underpinning to support the legal conclusion of obviousness.” *KSR Int'l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (emphasis added)).

Claims 27-31 depend directly or indirectly from claim 25. With regard to claims 27-31, Applicant hereby repeats and incorporates the above comments made with regard to claim 25. Specifically, Chan does not at least suggest a control line connecting a remote actuator and a pump, wherein the control line is adapted to advance the piston of the pump and therefore cannot render obvious claims 27-31. For at least these reasons, Applicant submit that claims 27-31 are in condition for allowance, and respectfully request withdrawal of the rejection.

Information Disclosure Statement

Applicant encloses an Information Disclosure Statement and PTO Form 1449, with copies of the references for the Examiner's review and consideration.

CONCLUSION

Applicant has made an earnest effort to place this case in condition for allowance in light of the remarks set forth above. Applicant respectfully requests reconsideration of the pending claims.

The Commissioner is hereby authorized to charge \$180 for the IDS and any additional fees necessary or credit any overpayments to Deposit Account No. 50-0359 of ArthroCare Corporation in order to effectuate this filing.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicant's attorney at 512.358.5925.

Respectfully submitted
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Date: 5/22/09

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Enclosures: 1) Information Disclosure Statement and PTO Form 1449.